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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,502	12/14/2001	Jane Ye	CL00001058DIV	3919
25748	7590	11/05/2003	EXAMINER	
CELERA GENOMICS CORP. ATTN: WAYNE MONTGOMERY, VICE PRES, INTEL PROPERTY 45 WEST GUDE DRIVE C2-4#20 ROCKVILLE, MD 20850			PATTERSON, CHARLES L JR	
			ART UNIT	PAPER NUMBER
			1652	

DATE MAILED: 11/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/014,502

Applicant(s)

YE ET AL.

Examiner

Charles L. Patterson, Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/12/03, 8/19/03 and 9/22/03.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,12,16,17 and 24-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,12,16,17 and 24-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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The disclosure is objected to because of the following informalities:

In the amendment to the specification filed 8/19/03, applicant state that the parent application, U.S. Patent 6,344,353, claims priority to 60/252,410. The examiner can find no reference to this provisional application in the parent filed, nor elsewhere in this file.

Appropriate correction is required.

Applicant's election without traverse of Group I in the paper filed 9/17/03 is acknowledged. Claims 3-11, 13-15, 18-19 and 22-23 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the paper filed 9/17/03.

Applicants state that they are electing Group I, claims 1-2 and 20-21, directed to polypeptides and have cancelled claims corresponding to the non-elected groups II-X. This is not true. To start with claims 20-21 have been cancelled by applicant so they cannot be examined, and there were only 7 groups in the restriction, not 10. Secondly, the non-elected claims have not been cancelled but are still pending. Thirdly, Group I was claims 1, 2, 12, 16-17 and 20-21, applicants omitted claims 12 and 16-17 from their reply. Fourthly, there are new claims 24-27 drawn to the polypeptide. Apparently, from applicants statement, they intended to elect for prosecution the group directed to the polypeptide, which now are claims 1, 2, 12, 16-17 and 24-27. The examiner will examine these claims and if applicants did not desire this they should so notify the examiner in their reply to this action.

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Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16 is indefinite in that it lacks antecedent basis for "any of the peptides of claim 2" and "the peptide".

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2 and 24-27 are rejected under 35 U.S.C. 102(b) as being anticipated by either of Wright, et al. (A) or Cromlish, et al. (U). Wright, et al. teach a human U937 protease from human histiocytic lymphoma cells (column 18, lines 19). Cromlish, et al. teach a human pituitary-derived serine protease. It is maintained that these enzymes are the protease of the instant claims, absent very convincing proof to the contrary. Sequencing of a protein does not affect the patentability of the protein *per se*.


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Claims 1-2, 12, 16-17 and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wright, et al. (A) or Cromlish, et al. (U). The references have been characterized *supra*. It would have been obvious and well within the skill level of one of ordinary skill in the art to detect the presence of the protein using an agent that binds to it and to make a pharmaceutical composition by adding a carrier to it. The motivation would have been to detect the protein and/or to test the protein in an organism.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles L. Patterson, Jr., PhD, whose telephone number is 703-308-1834. The examiner can normally be reached on Monday - Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy can be reached on 703-308-3804. The fax phone number is 703-308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.


Charles L. Patterson, Jr.
Primary Examiner
Art Unit 1652

Patterson
November 3, 2003